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DEPOSITION OF PREM S. SINGH -- 11/28/01

1 It's a completely different reaction mechanism and
2 kinetics.

3 Q Do the claims call for any of that?

4 A Well, claim calls for pyrolysis golden
5 brown products which are the results of that process.

6 Q So is it now your testimony that your
7 conception in 1988 did not include the use of a
8 liquid pyrolysis product?

9 A Ask again, please.

10 Q Is it now your testimony that your
11 conception in 1988 did not include the use of a
12 liquid pyrolysis product?

13 A '88 was not a liquid pyrolysis product.

14 Q And it's also your testimony that your
15 conception in 1988 did not involve the golden
16 browning of any product?

17 A There was no definition of golden
18 browning.

19 Q Just so we can confirm, you testified
20 that the shrinkage obtained or resulting from the use
21 of the Enersyst system was in the range of from about
22 2 to 3 percent; is that correct?

23 A That's correct.

PTO-003400

24 Q You testified that the inlet temperature

DEPOSITION OF PREM S. SINGH -- 11/28/01

1 We have a -- right now we have
2 equipment where we are testing it may take four or
3 five months because it's not just plug it in, run the
4 product, then you're done. Then you have to evaluate
5 the products chemically, you know, microbiologically,
6 sensory. So it's not just looking the oven and just
7 run the test. It's not atypical to run the test for
8 four or five months.

9 Q What were the results of these tests?

10 A It was complete failure from the
11 objective that was described to us.

12 Q And what objective was that?

13 A That you can brown the product without
14 any coating on it.

15 Q What about the other tests that you
16 conducted? What were the results?

17 A Well, the natural smoke that we hooked up
18 in there, that produced somewhat acceptable product.

19 Q What about the liquid smoke Maillose
20 tests?

21 A It was somewhat, again, successful.

22 Q Were any evaluations done of the product
23 produced using liquid smoke and/or Maillose?

24 A Say it again.

PTO-003401

1 UNITED STATES DISTRICT COURT
2 WESTERN DISTRICT OF OKLAHOMA
3 UNITHERM FOOD SYSTEMS, INC.,)
4 an Illinois corporation, and)
5 JENNIE-O-FOODS, INC., a)
6 Minnesota corporation,)
7 Plaintiffs,)
8 vs.) No. CIV 01-347-C
9 SWIFT-ECKRICH, INC., d/b/a)
10 CONAGRA REFRIGERATED FOODS,)
11 a Delaware corporation,)
12 Defendant.)
13
14 THIS DEPOSITION CONTAINS CONFIDENTIAL
15 ATTORNEYS' EYES ONLY MATERIAL
16
17 The continued deposition of CHRISTOPHER
18 SALM, called for examination, taken before GAIL
19 LIVIGNI, a Notary Public within and for the County
20 of Will, State of Illinois, and a Certified
21 Shorthand Reporter of said state, at Suite 200, 184
22 Schuman Boulevard, Naperville, Illinois, taken on
23 the 13th day of February, A.D., 2002, at 9:00
24 o'clock a.m.

ORIGINAL

PTO-003402

gl



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1 Patent?

2 A. I don't know if the Jonesboro plant is
3 using the Hunter color system as a quality check or
4 if we gave them color chips. Most times what we do
5 with the plant is we give them color reference
6 chips.

7 Q. What do you mean by color chips? I mean
8 a piece of product, or what are you talking about?

9 A. It can either be a photograph, or it can
10 be a painted --

11 Q. Just like a paint swatch when you're
12 painting your house?

13 A. Yes.

14 Q. Okay. So, you know, you don't have to
15 have this wand to produce a product that falls
16 within the claims of that '027 Patent, correct?

17 A. That is correct.

18 Q. Okay. You're lawyer yesterday asked
19 Mr. Hussain a technical question about having this
20 Hunter wand and how the values have to match up,
21 the color values match up to that wand, but you
22 don't use the wand to match the colors to the
23 product produced by the '027 Patent, correct?

24 A. We use the wand to determine the color

gl



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PTO-003403

1 A. Based on everything that I know, I
2 believe that he did.

3 Q. Okay. Now, with respect to liquid smoke
4 application, is it your testimony, I take it, that
5 Prem Singh shared that he had more expertise with
6 respect to liquid smoke application than Red Arrow
7 in 1990?

8 A. With respect to liquid smoke
9 application?

10 Q. Yes.

11 A. I believe so.

12 Q. Okay. And when is the next time Conagra
13 shared information as set forth in the '027 Patent
14 with Red Arrow, if you know?

15 A. I know in 1997, we defined the color
16 objective.

17 Q. The color objective for what product?

18 A. For the whole muscle turkey breast.

19 Q. And when you say defined color
20 objective, you mean the Golden Brown color which is
21 set forth in the '027 Patent?

22 A. Yes.

23 Q. And that's how you define the color
24 objective as being Golden Brown?

gl

1 A. Yes.

2 Q. Any other way you define that color
3 objective?

4 A. What do you mean?

5 Q. Well, I mean so you just told Red Arrow
6 the color objective that we are attempting to
7 achieve, I assume, with this new process that we
8 are developing is Golden Brown color, is that fair
9 to say?

10 A. We told them that it was Golden Brown
11 color. We showed them examples of Golden Brown,
12 and we showed them pictures that would represent
13 something close to Golden Brown.

14 Q. These examples of Golden Brown, was this
15 from product that was produced by Conagra or
16 product that was produced using other company's
17 ovens?

18 A. It was product that was produced by
19 Conagra.

20 Q. Where?

21 A. In our test kitchen.

22 Q. Where?

23 A. At Downers Grove.

24 Q. Using what oven?

PTO-003405

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1 Q. I understand that. But I'm talking
2 about obtaining the Golden Brown color for the
3 whole muscle meat product as set out in the claims
4 in the '027 Patent, is it your testimony here today
5 that that was Prem's idea to use a convection oven?

6 A. Yes.

7 Q. And when did he come up with that idea,
8 do you know?

9 A. It was 1989, 1990-ish.

10 Q. Okay. That's what he's told you,
11 correct?

12 A. Yes.

13 Q. Any other information that Conagra
14 shared with Red Arrow prior to the filing of the
15 patent?

16 A. No.

17 Q. What about Unitherm, what information
18 was shared with Unitherm -- I'm sorry, go ahead,
19 there was a question pending.

20 A. We shared the color objective with
21 Unitherm.

22 Q. When was that --

23 A. That was in --

24 Q. -- objective disclosed?

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1 A. February of 1998.

2 Q. Anything else?

3 A. I'm not sure.

4 Q. Well, I want you to be sure.

5 A. Right.

6 Q. If you need to look at the patent, then
7 you go ahead and look at the patent, but I want you
8 to be sure if there is any other information that
9 you shared with Unitherm that's disclosed in the
10 patent prior to the filing of the patent.

11 A. Right. I don't know that we shared
12 anything else.

13 Q. Other than color objective?

14 A. I know we shared color objective with
15 them.

16 Q. Right. And that was the Golden Brown?

17 A. Right, because I was there when that
18 happened.

19 Q. Did you have one of these Hunter wands
20 with you when you disclosed the color objective in
21 February?

22 A. Actually we showed them a picture.

23 Q. Picture of a piece of product?

24 A. Yes.

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1 Q. Okay. Was this the picture from the
2 General Electric oven product produced from the
3 General Electric oven?

4 A. Or other similar type oven.

5 Q. And you're looking at the patent right
6 now, so I don't want to interrupt you. I just want
7 to make sure that there is nothing else that you
8 disclosed to them.

9 A. I believe that was it.

10 Q. Who was present when you disclosed the
11 color objective to Unitherm?

12 A. I know that David Howard was present,
13 and I know that Prem Singh was present, and I know
14 that Chad Anderson was present.

15 Q. And this was disclosed to Unitherm
16 through David Howard in February of 1998 when you
17 visited the Unitherm facility in Ponca City?

18 A. Yes.

19 Q. Was Jim Wade present?

20 A. I don't recall that.

21 Q. What about the Heat & Control, you're
22 not sure whether you disclosed any of this
23 information to them?

24 A. I wasn't at the Heat & Control testing.

PTO-003408

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1 they keep those there at the plant?

2 A. Yes.

3 Q. In order to ensure this Golden Brown?

4 A. Yes.

5 Q. And that product is made from one or
6 more of the claims as set forth in the '027 Patent?

7 A. Yes.

8 MR. CASTRO: We haven't seen those color
9 chips, Bob, the color chip or the photographs, and
10 I think they would be responsive to our --

11 MR. SCHROEDER: We will look into that. I
12 certainly wouldn't have considered the color chip
13 to be a document anymore so than the equipment
14 itself would be produced.

15 MR. CASTRO: But the photograph.

16 MR. SCHROEDER: Well, we'll look into the
17 photographs.

18 BY MR. CASTRO:

19 Q. So when you moved the slice and serve to
20 the Jonesboro plant, what's the process that
21 produces that product now? You said it was a --
22 initially an Alkar oven?

23 A. Yes. I believe this is how they do it.
24 I haven't been at the plant since we moved that

PTO-003409

1 product there. We have a dip, that's a caramel
2 dip, that the product goes into. And then at that
3 time, I believe it was put back on racks and dried
4 and then packaged, cut and packaged.

5 Q. When you came up with this objective in
6 1998, why the Golden Brown color? This color
7 objective in '97, I guess, is when you came up with
8 it?

9 A. It was 1997.

10 Q. '97.

11 A. The objective was set off of a
12 Butterball Thanksgiving turkey as it came out of
13 the oven, and so that in effect defined the Golden
14 Brown that we were looking for. The "why" did we
15 come up with it?

16 Q. Yes.

17 A. Our marketing group did a marketplace
18 study and evaluated products in the marketplace
19 against our white product, products like the Sara
20 Lee product and the Boar's Head product.

21 Q. Jennie-O product?

22 A. No.

23 Q. No Jennie-O product?

24 A. Not that I recall. There was another

PTO-003410

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1 Q. And for you, you wanted to achieve an
2 oven roasted look, correct?

3 A. What we wanted to achieve was a look
4 that looked like a Butterball Thanksgiving turkey
5 when you first bring it out of the oven.

6 Q. Butterball oven roasted, how's that? Is
7 that what you were trying to achieve? You just
8 said a Butterball turkey just out of the oven.

9 A. The reason we didn't characterize it as
10 oven roasted was because we had an oven roasted
11 product in the marketplace that was white, and so
12 we wanted to make sure that we differentiated.

13 Q. I understand. The only reason you
14 didn't call it oven roasted is because you already
15 had an oven roasted product that was white,
16 correct?

17 A. And the golden oven roasted really
18 depicted what we had in mind for the product.

19 Q. What color is a Butterball whole turkey
20 when it comes out of the oven?

21 A. It's pretty close to a golden brown.

22 Q. That's what I thought.

23 A. Have you cooked one?

24 Q. Yes, I have tried. The existing product

PTO-003411

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1 A. That is true.

2 Q. And then they also had a proposal and a
3 price quote for the oven, correct?

4 A. That is correct.

5 Q. Those two items could produce a golden
6 brown product, correct?

7 A. I didn't say that.

8 Q. You saw the golden brown product
9 produced in 1993 during the testing?

10 A. At Unitherm?

11 Q. Yes.

12 A. I don't know if I characterized it as a
13 golden brown color. I don't recall saying that I
14 characterized it as a golden brown color.

15 Q. Was that a golden brown color?

16 A. It's a brown color.

17 Q. That must be a term of art akin to
18 patent law.

19 MR. SCHROEDER: Golden brown?

20 BY MR. CASTRO:

21 Q. In fact, you mixed caramel and Maillose,
22 didn't you? Here is a memo, No. 19. That's a
23 December 29, 1993 memo from you to others including
24 Prem Singh regarding a trip report at Wells plant,

PTO-003397

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1 MR. SCHROEDER: You think or --

2 MR. CASTRO: No, I pass the witness.

3 EXAMINATION

4 BY MR. SCHROEDER:

5 Q. Okay, just a few quick questions. With
6 reference to Exhibit 1, which is the Prem Singh
7 patent, you notice that starting with column five
8 of this patent, we have a series of examples, and
9 as to each example, the patent identifies a color
10 in terms of LAB values. Do you see that?

11 A. Right.

12 Q. Are you able to translate those LAB
13 values mentally into colors?

14 A. No, I cannot.

15 Q. Are you able to make a comparison, based
16 on this patent, without having equipment available
17 to you, between colors identified in this patent
18 and the colors that you would choose when you were
19 using Maillose?

20 A. I cannot.

21 Q. Do you know whether you ever achieved a
22 golden brown color in the sense in which that term
23 golden brown is used in the context of this patent?

24 A. No, I don't know.

PTO-003398

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1 Q. Now, how did you do that with regards to
2 this '027 Patent?

3 A. We did it a couple of ways. As I
4 mentioned, we tried to determine based on what we
5 could see in the marketplace and then we did a
6 literature search.

7 Q. What do you mean what you could see?
8 Did you go to plants, to facilities to see what
9 kind of process they were running?

10 A. No, no.

11 Q. What do you mean by that?

12 A. Well, we went into the marketplace and
13 we tried to find products that would be similar to
14 this golden oven prepared product oven roasted
15 product of ours.

16 Q. And you found those products, right?

17 A. Did not.

18 Q. Well, you don't know how those products
19 were prepared, do you?

20 A. I didn't see anything that looked like
21 our product.

22 Q. So if something is prepared identically
23 to how you've laid it out in the patent but it
24 doesn't produce a golden brown product, then it

PTO-003412

gl

1 doesn't infringe your patent?

2 A. I would say that's correct.

3 Q. Okay. So it all depends upon the color
4 of the product, the finished product, after you
5 follow the claims set forth in the '027 Patent?

6 A. Yes.

7 Q. Is it your testimony today that your
8 competitors, none of your competitors, had a
9 product similar in color to the product you
10 produced in 1999 using the '027 Patent?

11 A. In 1998?

12 Q. Okay, '98.

13 A. Yes.

14 Q. None of them had a golden brown color?

15 A. Yes.

16 Q. Yes, none of them did?

17 A. Yes, none of them did.

18 Q. Okay. Who did that? Who did that
19 sensory -- would you call it sensory testing
20 because I mean it's a visual, you're looking at the
21 color of the product? Who performed that visual
22 inspection? Was that done by the marketing people
23 or who?

24 A. No. There were a number of people that

PTO-003413

gl

1 were involved in that.

2 Q. Name them.

3 A. I know that Prem Singh was involved in
4 that. I know that I was involved in that. I know
5 that Rich Scalise was involved in that, and I
6 believe that Rich Scalise asked his salespeople in
7 the field.

8 Q. What was your involvement in trying to
9 see whether there was other product that looked
10 golden brown? What did you do?

11 A. I looked at deli cases in the
12 marketplace.

13 Q. You literally went to -- what kind of
14 stores do you got up here? What did you go to,
15 like grocery stores?

16 A. We have grocery stores that go by the
17 name of Jewel and Dominicks.

18 Q. Okay. So you walked into these -- you
19 yourself walked into these grocery stores and
20 looked behind the casing, behind the glass case?

21 A. Yes.

22 Q. To see whether anyone had a golden brown
23 product?

24 A. Yes.

PTO-003414

1 Q. Hey, what if someone said this does come
2 close? Don't you think it would be good to keep
3 those records to prove to them that before you
4 filed your patent, that you could say that they
5 didn't come within these examples anyway?

6 A. Are you asking my opinion?

7 Q. Yes.

8 A. I didn't think of it at the time.

9 Q. You didn't run one of those Hunter wands
10 at the deli counters, did you?

11 A. No.

12 Q. Do you know if Prem did? Did he take
13 one with him?

14 A. No.

15 Q. Did you go anywhere else? Did you go to
16 any food service facilities?

17 A. No.

18 Q. I will hand you -- and I am not going to
19 mark it as an Exhibit. It's something that your
20 office produced to me. Are these competitors of
21 yours that you looked at their products back at the
22 time?

23 A. I expect that we would have.

24 Q. Bates stamp number CRPF 07614?

PTO-003415

gl

1 A. Yes.

2 Q. Those people you are looking at their
3 product, it's Boar's Head, Dietz & Watson, Hormel,
4 Jennie-O, Perdue, Sara Lee, Willowbrook Farms,
5 Butterball, Healthy Choice -- well, those are your
6 three. Peter Eckrich, Healthy Choice and
7 Butterball are yours, right?

8 A. Yes.

9 Q. Does that help refresh as to the
10 competitors you looked at?

11 A. I couldn't tell you that.

12 Q. That's something better left for Sue.
13 Burns?

14 A. Yes.

15 Q. Do you remember looking at those
16 products behind the deli counter?

17 A. I know in our area we have Sara Lee, and
18 I know that we have some Hormel product.

19 Q. Did you look at the Hormel product?

20 A. Yes.

21 Q. None of it had this golden brown color?

22 A. No. I believe the Hormel product was a
23 smoked product.

24 Q. Is it your testimony that if you have a

PTO-003416

1 A. I don't know.

2 Q. Have you seen that product?

3 A. I have not.

4 Q. Did you look at it back in '98, any of
5 their product?

6 A. We looked at Jennie-O product. We did
7 not find a golden brown product.

8 Q. Is it your testimony today that if it's
9 not a golden brown product, it doesn't fall within
10 your patent?

11 MR. SCHROEDER: Objection, lacks foundation,
12 beyond the competency of the witness and outside
13 the 30(b) (6) notice.

14 BY MR. CASTRO:

15 Q. If you can answer it.

16 A. That would be my opinion.

17 Q. Okay. What products of other companies
18 are competitive with the products produced by the
19 '027 Patent?

20 A. Excuse me, ask that again.

21 Q. Yes. What products are competitive with
22 your --

23 MR. SCHROEDER: I don't believe that that
24 question falls within any of the areas which this

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1 experience, that's how you smoke part of your
2 product, right?

3 A. We smoke products in batch houses, yes.

4 Q. How long does it take to smoke products
5 in batch houses?

6 A. It depends on the house that we use, but
7 anywhere from 20 minutes to two hours, three hours.

8 Q. Can you smoke product using your
9 process?

10 A. I know in the background of the
11 invention, we describe the processes that are
12 in-line that smoke products and produce smoked
13 products.

14 Q. My question is can you smoke product
15 using your process?

16 A. I don't know that you can get a golden
17 brown smoked product. I don't know. I just don't
18 know that. I suppose with the right combination of
19 ingredients, maybe you could.

20 Q. If a competitor smoked the product using
21 the process as set forth in the patent, would that
22 be -- would that fall within the claims of the
23 patent?

24 A. If they're using a pyrolysis product on

PTO-003418

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1 A. Yes.

2 Q. Would it have been someone the marketing
3 people would have looked at to view their color?

4 A. It's possible.

5 Q. Okay. When was the company first able
6 to achieve a golden brown color on product?

7 A. I can't tell you exactly. We didn't
8 measure those colors in 1989 and '90. It's
9 possible that we could have achieved those colors
10 then in testing that was done. It's possible that
11 we could have achieved those colors anywhere along
12 the way. We didn't measure those until 1997.

13 Q. It's possible you could have achieved
14 the golden brown color with ovens provided by
15 Stein, correct?

16 A. Yes.

17 Q. It's possible you could have achieved
18 the golden brown color with ovens provided by
19 Koppens, correct?

20 A. Yes.

21 Q. It's possible you could have achieved
22 the golden brown color with ovens provided by
23 Unitherm, correct?

24 A. Yes.

PTO-003419

gl

1 Q. You didn't measure with this Hunter
2 wand, is that why you don't know whether you
3 achieved the golden brown color?

4 A. Yes.

5 Q. What did you buy from Convenience Food
6 Group in 1998 or '99? Did you acquire an oven from
7 Convenience Food Group?

8 A. In 1998, we purchased a Koppens oven.

9 Q. So they make the Koppens oven?

10 A. Yes.

11 Q. And that's still in production today?

12 A. Yes.

13 Q. It's still operating?

14 A. Yes.

15 Q. Do you still produce a cooked in the bag
16 turkey product, a white turkey product?

17 A. I don't know exactly all the products
18 that are produced in the Longmont facility, but
19 there may be some white products that are produced
20 there. I don't believe that we produce any of
21 those in Jonesboro.

22 Q. Well, when you're here testifying today,
23 you're talking about all the facilities at Conagra,
24 aren't you? I want to make sure we're clear.

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1 what, year or two, that there were other companies
2 using the Unitherm system? Did Gary tell you that?

3 A. No.

4 Q. Did you ask him?

5 A. No.

6 Q. Prior to filing of the patent in May of
7 1998, wasn't Conagra informed of other companies
8 that were using the process that Unitherm
9 demonstrated in '98?

10 MR. SCHROEDER: Objection, assumes a fact not
11 in evidence and misleading.

12 BY MR. CASTRO:

13 Q. No, did Conagra inform -- did Unitherm
14 inform you prior to filing of the '027 Patent that
15 there were other companies using the process that
16 was demonstrated at their facility in February of
17 1998?

18 A. No.

19 Q. Did they inform anyone at Conagra?

20 A. Not that I'm aware of.

21 Q. Did you disclose any trade secrets to
22 Unitherm when you were at their facility in
23 February of 1998?

24 A. To the extent that we ran the tests to

1 achieve our targeted color, the color objective,
2 that color objective for us and the fact that we
3 were contemplating that was a trade secret.

4 Q. Did you tell them that?

5 A. Yes.

6 Q. Did you have them sign a confidentiality
7 agreement?

8 A. No.

9 Q. Don't you normally have vendors, third
10 parties, sign confidentiality agreements prior to
11 disclosing trade secrets?

12 A. We normally leave that up to our
13 purchasing group to have confidentiality agreements
14 on file. That was a procedure prior to that.

15 Q. You knew that there was no
16 confidentiality agreement on file with Unitherm
17 prior to the visit in February of 1998, didn't you?

18 A. No, I did not.

19 Q. Didn't Prem?

20 A. No.

21 Q. How do you know that?

22 A. We talked about it.

23 Q. Did you? Before you went or after?

24 A. After.

PTO-003422